

REMARKS

This paper is submitted in response to the Office Action mailed October 27, 2004. Following this amendment, Claims 1, 4-20, 22-31, 47-49 and 51-56 are pending. Claims 1, 4-14, 17, 23-26, 47, 49 and 53 are allowed. Claims 14, 15, 18, 22, 29, 48 and 52 have been amended, as discussed below. Claims 54-56 have been added. No new matter has been introduced by the amendments or new claims. Applicants reserve the right to pursue any cancelled subject matter in divisional, continuation or continuation-in-part applications.

Claim Objections

Claim 22 has been objected to under 37 C.F.R. 1.75 (c) as being in improper dependent form for failing to further limit the subject matter of a previous claim. Claim 22 depends from claim 14, which is directed to the human TNF- α gene. The Examiner alleges that claim 22 is directed to inserting a cis-acting element into the intron of human TNF- α and that the human TNF- α gene already has a cis-acting nucleotide in an exon (3'UTR) of the gene, but not in an intron. The Examiner further alleges that if the cis-acting element is inserted into an intron of the human TNF- α gene, then it is no longer the human TNF- α gene. The Examiner, therefore concludes that the subject matter of claim 22 is outside of the scope of claim 14 and does not further limit the subject matter of claim 14.

In response, Applicants have amended claim 14 to depend from claim 12 and claim 22 to depend from claim 13. Claim 22 now recites inserting a cis-acting nucleotide sequence inserted into an intron, as discussed in the specification beginning at page 23, line 26 to

page 24, line 9. Therefore, Applicants respectfully request withdrawal of the objection to claim 22.

The Examiner has objected to claim 29 as being improper because it is a multiple dependent claim depending from multiple claims with different features and another multiple dependent claim. Claim 29 has been amended to only depend from claim 27. New claim 54 has been added to recapture the cancelled subject matter from claim 29, i.e. depend from claim 28. New claims 55 and 56 correspond to claims 30 and 51.

The Examiner has objected to claim 48 for being a substantial duplicate of claim 49. Applicants have amended the preamble of claim 48 to recite "a method for producing a transfected cell capable of producing a protein" and have deleted step c). Therefore, the claims are distinguishable in that claim 48 relates to producing a transfected cell and claim 49 relates to producing a protein from a transfected cell.

Rejections Under 35 U.S.C. § 112, second paragraph

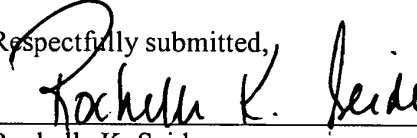
The Examiner has rejected claims 15, 16, 18-20, 48 and 52 under 35 U.S.C. 112, second paragraph, for being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner notes that there is insufficient antecedent basis for "said cis-acting element" in claims 15 and 18, "the cells" of step (b) in claims 48 and 52, and "culturing the cells obtained in (b) of step (c) in claim 52.

In response, Applicants have amended claims 15, 18, 48 and 52 to correct the insufficient antecedent basis and respectfully request withdrawal of the rejection of the claims under 35 U.S.C. 112, second paragraph.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests withdrawal of the outstanding rejections and allowance of the rejected pending claims.

Applicants do not believe that any fee is required for this filing. Nevertheless, the Commissioner is hereby authorized to charge any fees required for this submission not otherwise enclosed herewith to Deposit Account No. 02-4377. A duplicate copy of this page is enclosed.

Respectfully submitted,

Rochelle K. Seide
Patent Office Reg. No. 32,300
Attorney for Applicants

BAKER BOTTS, L.L.P.
30 Rockefeller Plaza
New York, NY 10112
(212) 408-2500